



ROY-007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Kenneth Austin	)	
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Intl. Appl. No.:	PCT/GB98/02166	)	
		)	
Intl. Filing Date:	July 20, 1998	)	Examiner: Thai Q. Tran
		)	
Serial No.	09/601,712	)	Group Art Unit: 2616
		)	
Filing Date:	September 27, 2000	)	
		)	
For:	VIDEO MEDIA CONTROL SYSTEM	)	Attorney Docket No. ROY-007
		)	

**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper is responsive to the Examiner's Office Action dated November 3, 2004. In that Office Action, the Examiner required restriction to one of the inventions in Group I (claims 1-32, 40-46), Group II (claim 33), Group III (claim 34), Group IV (claim 35), Group V (claims 36-38), Group VI (claim 39), or Group VII (claim 47). Please note that claims 33-35 (Groups II-IV) were cancelled without prejudice by the Preliminary Amendment filed on August 4, 2000 and are not currently pending. Claims 1-32 and 36-47 (Groups I, V-VII) are pending.

Applicant provisionally elects Group I (claims 1-32 and 40-46) for prosecution but respectfully traverses the Restriction Requirement and requests reconsideration. Applicant further reserves the right to file divisional and/or continuation applications on the subject matter of the non-elected claims if the Restriction Requirement is not withdrawn.

This Restriction Requirement should be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §1.141. 35 U.S.C. §121 provides that the Commissioner may

restrict an application when "two or more independent and distinct inventions are claimed in a single application." (emphasis added). Similarly, 37 C.F.R. §1.141(a) permits restriction conditioned upon the finding that independent and distinct inventions are found within a single application.

Applicant respectfully submits that Groups I, V, VI and VII relate to a single general inventive concept under PCT Rules 13.1 and 13.2. The claims of Group I are directed generally to a video storage media control system including means operable to control a video media storage device. The claims of Groups V and VI are also directed towards a media device control system which includes steps for controlling a media device. Groups I, V and VI are thus all include claims directed towards a system for controlling a media device such as a video recorder. The claim of Group VII is directed towards a method of using such a media control system. With regard to Groups I and VII, PCT Rule 13 permits the inclusion of an independent claim for a given product and an independent claim for a use of the product. M.P.E.P. §1850. Unity of invention under PCT Rule 13 is thus present in Groups I, V, VI and VII and the claims of those Groups should be examined together.

Moreover, Applicant respectfully submits that the subject matter in Groups I, V, VI and VII is so closely related that a search and examination can be conducted without serious burden to the Examiner within the meaning of M.P.E.P. §803. Examination of claims in Groups V, VI and VII in future divisional or continuation applications would require searching the same body of prior art as the elected claims in Group I. Given that Groups I, V, VI and VII are directed towards such closely related media control systems, restriction would only serve to create added work and expense for the U.S. Patent and Trademark Office, inequitably burden the Applicant with unnecessary expenses, and deprive the Applicant of the benefits of the full term for any subsequent patent to the subject matter to which he is

entitled.

Applicant respectfully submits that in view of increased Official Fees and the need to file divisional applications substantially concurrently, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive, and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts.

Furthermore, withdrawal of the Restriction Requirement would not place an undue search burden on the Examiner, particularly in view of the fact that the Office now exclusively utilizes computerized searching. A computer can handle searches within multiple classifications and with multiple search terms just as effectively as a search within a single classification, and with considerably less effort than the previous practice of manual searching within a single class.

It is also noted that the Requirement for Restriction is not mandatory under 35 U.S.C. §121 and 37 C.F.R. §1.142, but is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made Restriction Requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. *See e.g., Eversharp, Inc. v. Phillip Morris, Inc.*, 356 F.Supp. 778, 150 U.S.P.Q. 98 (E.D.Va. 1966); *aff'd* 374 F.2d 511, 153 U.S.P.Q. 91 (4<sup>th</sup> Cir. 1967). Therefore, to promote the interests of the public and the Applicant, a Restriction Requirement should not be imposed without a specific analysis which supports conclusions that two or more independent and distinct inventions are indeed claimed in one application.

The courts have also recognized the advantages of the public interest to permit patentees to claim all aspects of their invention, as Applicant has done herein, so as to encourage patentees to make a more detailed disclosure of all aspects of their invention.

The Court has observed:

We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore describe in the manner required by 35 U.S.C. §112, all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

*In re Kuehl*, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Applicant thus respectfully requests that the Restriction Requirement be withdrawn and that the claims in Groups I, V, VI and VII be examined together. Since the Applicant has provisionally elected an invention and has fully and completely responded to the foregoing Office Action, the present application is now in condition for an early action on the merits of at least with regard to the elected Group I (claims 1-32, 40-46).

Respectfully submitted,

February 3, 2005

By



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 3, 2005.



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Michael A. Hierl